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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,898	01/06/2004	Brett J. Buchanan	BBUCP101USA	5093

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EXAMINER

LEFF, STEVEN N

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,898

Applicant(s)

BUCHANAN, BRETT J.

Examiner

Steven Leff

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>33391</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claims 2-9, 11-17, 20, 22, and 27 are objected to because of the following informalities:

- The word “wherein” should be inserted after the comma.
For example: The toy of claim 10, wherein...
- Claim 21 the word “an” should be replaced with “a”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 USC 112 first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase “a shell shaped to facilitate oral interaction with the animal...” was not described in the specification with regard to what constitutes a shape that facilitates oral interaction.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18, and 21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-18, specifically claims 1, and 10 are rendered indefinite due to the phrase “with the shell”. It is unclear as to what “with” is intended to encompass. For example, it is unclear whether the edible material is part of the shell or encased in the shell.
- Regarding claims 2, 5, 8, 13, 23, 24, the recited format does not comply with accepted U.S. Patent practice with regard to the recitation of Markush grouping of claim

elements. Phrases using “comprising” should recite elements in the alternative (i.e. “comprising A, B, C or D”), whereas closed sets (“consisting of”) should recite elements as “selected from the group consisting of A, B, C and D.” In the instant case, the term “includes” is interpreted as open language, similar to “comprising.”

- Claim 11 is rendered indefinite due to the word “about” which does not clearly define where the bonding is taking place.
- Claim 15 is rendered indefinite due to the description of a “non-edible material”. Claim 10, from which claim 15 depends, refers to the toy as “consumable in its entirety”.
- Claim 15 is further rendered indefinite by the word “slowly”. It is unclear as to what time frame “slowly” is meant to represent. For example, is “slowly” meant to represent time as a function of seconds, days or years?
- Claims 21-27 are rendered indefinite due to the phrases “that houses...” which is then followed by “inserting the edible material.” The shell can not be depicted to house the edible material before the edible material has been inserted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1,3, 5, 10-13, 15, 17, 18, 21-23, 26, and 27 are rejected under 35 USC 102(b) as being anticipated by Brekau (DE-29703253)

A ball for cats to play with is formed as two half-shells, connected together, and a cat food filling may be included. Preferably, the surface has varied forms, such that the cat uses it as a play ball, and the casings may be of edible or non-edible material and may contain or be entirely comprised of an edible material. (abstract)

The ball appeals to the natural hunting and play instincts of cats. The ball could be filled with edible material allowing the entire toy to be consumed. However, Brekau further discloses

that in the case of a non-edible shell the toy can be manually filled with cat food. The outside of the shell could additionally include recesses or projections. (fig. 2)

Therefore, Brekau teaches an edible toy for a cat with half-shells which may or may not be edible and could further include cat food. With regard to the edible material slowly being released through the holes, due to the broadness of the claim the edible material could be viewed as anything, including an edible liquid. Since the viscosity of the material would affect the rate that the material passes through the holes, a less viscous substance would tend to pass through the holes faster.

- Claims 1-5, 10, 14, 16, and 18 are rejected under 35 USC 102(b) as being anticipated by Smith (1022113)

Smith teaches a “device in the form of a ball because a toy of such shape is easier for a cat to play with...” (pg. 2 col. 1 lines 7-9) Smith further teaches the “ball could be made either partially or entirely of a catnip compound,” (pg. 1 col. 1 line 49+) and “may include an exterior coating of the catnip compound,” (pg.1 col. 2 line 87+) “so that the cat may always be able to get the odor or taste or both of the catnip.” (pg. 1 col. 2 line 76+) Smith further teaches “catnip compound contained other herbs ...the odor of which is attractive to cats.” (pg.2 col. 1 line 3+)

In the instant instance where catnip is viewed as edible or consumable, Smith teaches an edible cat toy.

- Claims 2, 4, 9, 14, 16 and 19-20 are rejected under 35 USC 102(b) as being anticipated by Denesuk et al. (6178922)

Denesuk et al teach a mastication article for a domestic animal comprising tough chew-resistant material defining a shape in the form of a small article for enticing or being retrieved by a domestic animal, and an effective amount of microbe-inhibiting agent applied to or incorporated in the material. The mastication articles may be fabricated in various shapes, designs, and styles. A process for applying the microbe-inhibiting agent to the material for forming the mastication article is disclosed. Application methods include spraying and soaking the article, and incorporating the agent within a resin or material for forming the article. The article can be digestible in whole or in part.

Denesuk et al further teaches “an amount of catnip or catnip oil can entice a cat to chew or otherwise be attracted to the article. Comminuted catnip, for example, can be added to the

hopper with the raw materials.” (col. 15 lines 66+) “A digestible mastication article is selected from a group consisting of animal skin, animal fat, vegetable, a vegetable starch or some blend thereof.” (col. 3 line 65+) The article before applying the microbe-inhibiting agent could be of a single homogeneous mixture, or a mixture with a primary edible component within a blend. “The step of incorporating the microbe-inhibiting agent includes applying the solution to the... material after the article has been formed.” (col. 5 line 3+) The mastication article 30 may be hollow, having a open center 34, as shown in FIG. 5, or solid (not shown). (col. 6 line 10) Denesuk et al further describe the different processes with which the article could be made, and the differences in toughness with respect to these different methods. (col.13 line 14+)

Therefore Denesuk et al anticipates the edible cat toy that includes catnip, and each toy may have different characteristics depending on materials, and the process of forming. Further, in the instant instance where the microbe-inhibiting agent is viewed as the shell, chewing and/or biting of the article would cause an amount of the edible material to be released. There is no emphasis being placed on the quantity of edible material that is required to be released.

- Claims 6, 7, and 9 are rejected under 35 USC 102(b) as being anticipated by Fisher

Fisher discloses an animal food that is shaped and includes multiple layers of edible materials. The edible layers can be made of food components such as those animal foods currently used and known and are preferably in a dry, shelf-stable form such as dried meats, dried fish, fish meal, fish flour, cereals, fruits, etc., with or without food additives or supplements such as vitamins, minerals, medicinals, etc. The layered product could employ as many layers as desired with the combinations herein being infinite such as 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, or more layers. (col. 9 line 22) The outside layer can be viewed as the shell. Each layer may or may not include safely ingestible structure supporting fibers, (abstract) and the layers may be formed around a core by dipping the core repeatedly in rawhide or collagen fiber-containing pet food. Therefore the pet food can be built up to yield a product with different thickness layers. Fisher further discloses that the chew-resistance or hardness of the product could be a function of “the pressure employed in compacting the product.” (col.2 line 25)

Therefore Fisher anticipates the cat toy of different layers of edible materials, and the edible materials being formed concentrically around the core. Fisher further anticipates that the hardness of the toy is a function of the pressure during compaction.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brekau (DE-29703253) in view of Markham (5947061).

With regard to claim 8, Brekau teaches an entirely edible or inedible toy which could include projections on the exterior.

Markham (5947061) teaches a pet toy that includes recesses that form openings which extend through the sidewall of the pet toy for receiving treats. Markham however does not teach that the entire toy is consumable.

However because Brekau teaches the use of an entirely consumable pet toy, that may include projections, and Markham teaches holes in the sidewall of the shell for holding treats, one of ordinary skill in the art would have been motivated to have combined the teachings of Brekau and Markham to produce a completely edible toy with edible projection on the surface. Further, both Brekau and Markham are interested in producing play toys for pets with projections. The use of a one-piece construction, where the shell and projections are edible, instead of the structures disclosed in Brekau and Markham would be merely a matter of obvious engineering choice. (see MPEP 2144.04 V(b))

Therefore with respect to claim 8 it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have made or produced a pet toy with an edible shell and projections.

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- Claims 18, 24, and 25 are rejected under 35 USC 103(a) as being unpatentable over Brekau (DE-29703253) in view of Smith (1022113).

Brekau was taken as cited above.

Smith teaches a "device in the form of a ball because a toy of such shape is easier for a cat to play with..." (pg. 2 col. 1 lines 7-9) Smith further teaches the "ball could be made either partially or entirely of a catnip compound," (pg. 1 col. 1 line 49+) and "may include an exterior coating of the catnip compound," (pg.1 col. 2 line 87+) "so that the cat may always be able to get the odor or taste or both of the catnip." (pg. 1 col. 2 line 76+)

Smith however does not teach that the catnip ball is edible.

However because Brekau teaches that the entire toy may be consumed, and Smith teaches a ball which is made entirely or partially of the same component with a coating, one of ordinary skill in the art would have been motivated to have combined the teachings of Brekau and Smith to produce an edible pet toy. Both Smith and Brekau teach the positive solution of entertaining a cat by producing a toy that includes flavor agents, or inducements. As is commonly shown in the art, and evident by Brekau, the production of an entirely edible cat toy is of particular interest. Brekau teaches all of the limitations which respect to the identified claims except for the percentage make-up of the different edible components which form the toy. Smith shows that a completely homogenous toy and a toy of different edible components are possible. Forming the toy with or without a shell would be merely a matter of obvious engineering choice considering Smith teaches a catnip coating.

Therefore with respect to claims 18, 24, 25, it would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to have made or produced a pet toy with a shell and a completely edible body of one component or more components.

Allowable Subject Matter

There is no allowable subject matter at this time.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as listed on pto-892 references cited. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL


KEITH HENDRICKS
PRIMARY EXAMINER